

REMARKS

At the time of the Office Action dated June 6, 2007, claims 8-14 were pending and rejected in this application. Claims 8, 10-11, and 13 have been amended, Applicants submit that the present Amendment does not generate any new matter issue.

On page 8 of the Sixth Office Action, the Examiner objected to the term "substantially empty" as failing to have proper antecedent basis in the specification. In this regard, Applicants note that not all claimed terms are required to have antecedent basis in the specification. Notwithstanding, Applicants note that the Appellants' disclosure includes several discussions of a substantially empty message and empty message. Moreover, the phrase "substantially empty message" is self-defining. For example, one would not be required to explain the term "substantially empty bucket." An empty bucket is empty, and a substantially empty bucket is empty but not necessarily to the nth degree.¹ Similarly, an empty message does not contain any information, but it not necessarily absent information to the nth degree. Therefore, Applicants respectfully solicit withdrawal of the imposed objection to the specification.

CLAIMS 8, 10, 11, AND 13 ARE REJECTED UNDER THE SECOND PARAGRAPH OF 35

U.S.C. § 112

On page 8 of the Office Action, the Examiner separately asserted that claims 8, 10, 11, and 13 are indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. This rejection is respectfully traversed.

¹ The use of the word "substantially" is ubiquitous in patent claims and specifications and has been judicially approved in recognition of the elusiveness of absolute perfection, i.e., absolute purity to the nth degree. See Andrew Corp. v. Gabriel Electronics, Inc., 847 F.2d 819, 6 USPQ2d 2010 (Fed. Cir. 1988).

Applicants note that each of claims 8, 10, 11, and 13 have been amended to remove the phrase "the step of." Thus, the imposed rejections of claims 8, 10, 11, and 13 under the second paragraph of 35 U.S.C. § 112 have been overcome and, hence, Applicants respectfully solicit withdrawal thereof.

CLAIMS 8-9 AND 11-14 ARE REJECTED UNDER 35 U.S.C. § 102 FOR ANTICIPATION

BASED UPON HERZ

On pages 9-12 of the Sixth Office Action, the Examiner asserted that Herz discloses the invention corresponding to that claimed. This rejection is respectfully traversed.

Applicants incorporate herein the arguments previously presented in pages 3-12 of the Appeal Brief filed January 24, 2007.

On page 4 of the Sixth Office Action, the Examiner asserted the following:

However, claim 8 does not even recite keywords and target objects so the applicant's statement that claim 8 does recite such features is fallacious. Even if, for argument's sake, claim 8 did recite such limitations Herz teaches these features as shown in col. 56, lines 2 1-25. The mentioned attributes can be keywords and target objects. The keywords and target objects are considered the filter expressions.

The Examiner has mischaracterized Applicants' arguments. The basis of Applicants' arguments is the following: (i) the Examiner has relied upon "keywords and target objects," presumably, to teach the claimed "at least one attribute." Applicants' argument was directed to the fact that if the Examiner is to rely upon "keywords and target objects" then Herz has to teach that "the keywords and target objects" are found in a subscription request, since claim 8 recites that "the request includes a filter expression having a least one attribute." Applicants used the phrase

"keywords and target objects" since these were terms used by the Examiner to allegedly disclose the claimed features. Thus, it is proper and not "fallacious" for Applicants, upon describing what Herz fails to teach, to refer to terms used by the Examiner.

In the paragraph spanning pages 4 and 5 of the Sixth Office Action, the Examiner asserted the following:

However, this argument completely ignores the description (or lack there of) of a "first type" given by the applicant's specification. The only description the applicant's specification gives for types is that a subscription request is of type "A" and a publication is of type "B" (See page 18 of applicant's specification). There is no limiting definition of what a "type" comprises. Therefore the Examiner's interpretation that the "search profile" is of a "first type" and the "target profile" is of a "second type" is consistent with the applicant's broad disclosure.

Applicants respectfully submit that the Examiner has not considered the entirety of Applicants' disclosure. In this regard, the Examiner is referred to the paragraph spanning pages 5 and 6 of Applicants' disclosure and reproduced below:

FIG. 3 shows two example message formats A and B. It can be seen that message A has two headers (HDR1; HDR2) and a main body, whilst message B has three headers (JHDR1; JHDR2; JHDR3) and a body. In messages of type A the attribute, X (i.e Salary), sits in the second header. In messages of type B this same attribute sits in the third header. Thus it will be appreciated that the attribute itself typically has a common description, but its location may vary between message formats. The position of the attribute is typically used as a naming protocol for the identifier node. Thus it can be seen from FIG. 2 that the subscription request is of message type A since identifier node 110 has the name HDR1.HDR2.Salary showing that the attribute Salary sits in the second header.

Thus, as described in Applicants' disclosure the different "types" refer to the format of the message relative to where a particular type of filter expression is located within the message. In this regard, Applicants note that the claims have been amended to clarify that the "first type" now refers to a "first filter expression format type." Thus, as claimed, the first type refers to the formatting of the filter expressions within the request. The claimed "second type" has been similarly amended, and refers to the formatting of the filter expressions within the publication message.

In the first full paragraph on page 5 of the Sixth Office Action, the Examiner asserted the following:

The applicant goes on to allege that the Examiner must be relying on inherency. The Examiner, however, had made it clear how Herz reads on all of the applicant's claimed elements in the last office action and thus explicitly teaches the claimed invention. The applicant alleges that "a subscriber in Herz could submit a subscription request that is completely separate from the search parameters that are used." In response to this statement, the Examiner points out that the applicant provides no example from Herz that supports this conclusion and that the applicant's claims have nothing to do with a user anyway.

In response, Applicants note that the Examiner has still failed to establish that Herz explicitly teaches all of the limitations of the claimed invention. Much of the Examiner's analysis relies on unstated claim construction and unstated analysis to which Applicants are not privy. Moreover, as to Applicants' example as to why Herz does not identically disclose a particular feature, Applicants note that this example is not required of Applicants. Instead, the initial burden of establishing inherency rests with the Examiner. Thus, Applicants are not required to provide any factual support unless and until the Examiner factually supports the Examiner's inherency arguments.

In the paragraph spanning pages 5 and 6 of the Sixth Office Action, the Examiner asserted the following:

In response the Examiner points out that the applicant does not describe the claimed (i) generic format; (ii) that at least one attribute; and (iii) the mapping (See page 18 of the applicant's specification). Given that the applicant's specification provides no limiting definition for these terms, the reasoning previously supplied in the Final Rejection is all that can be expected of the Examiner. Specifically the Final Rejection stated that in Herz col. 57, lines 39-51, the search profiles are mapped to generic cluster profiles. As previously discussed the search profiles contain keywords and target objects, considered attributes.

Under 35 U.S.C. § 102, the applied prior art must identically disclose each limitation of the claimed invention. Generic cluster profiles are not a generic format. The term "format" has a readily discernable meaning and although a profile may have a format, a profile is not the same

as a format. Also, "profiles [being] mapped to generic cluster profiles" does not identically disclose "mapping the generic format filter attribute to a format." Notwithstanding the Examiner's assertion that a profile includes attributes, the mapping of a profile is not necessarily comparable to the mapping of an attribute.

On page 6 of the Sixth Office Action, the Examiner asserted the following:

In response the Examiner points out that the "article" is considered the "publication message". The claims do not stipulate where it is received but only that it is received. In col. 57, line 6-col. 58, line 54, the Articles have clearly been received by the system of Herz at some point. As discussed previously, the applicant does not even describe a "second type" so the claim can only be interpreted broadly.

As noted above, Applicants have amended the terms "first type" and "second type." As such, the Examiner's comments are moot.

On page 7 of the Sixth Office Action, the Examiner asserted the following:

With respect to the dependent claims, the applicant alleges that the claim limitations are generally not taught without an elaboration. The explicit mapping of provided in the rejections of these claims shows how the claims are being interpreted. The rejection would not have been set forth if it was not believed that Herz taught the claim limitations.

Applicants do not doubt the Examiner has a reason for rejecting the dependent claims. However, the Examiner has not fully shared these reasons with Applicants. What has been provided by the Examiner are incomplete findings of fact without analysis and without claim constructions. Applicants are not in a position to guess/speculate as to the reasons why an Examiner is rejecting a particular claim or as to the claim construction that the Examiner is employing to reject a particular claim.

As noted by the Supreme Court in Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.,² a clear and complete prosecution file record is important in that "[p]rosecution history estoppel requires that the claims of a patent be interpreted in light of the proceedings in the PTO during the application process." The Courts that are in a position to review the rejections set forth by the Examiner (i.e., the Board of Patent Appeals and Interferences, the Federal Circuit, and the Supreme Court) can only review what has been written in the record; and therefore, the Examiner must clearly set forth the rationale for the rejection and clearly and particularly point out those elements within the applied prior art being relied upon by the Examiner in the statement of the rejection.

Notwithstanding the previous-presented comments, Applicants note that the claims have been amended to clarify that the first type is first filter expression format type and the second type is a second filter expression format type and that the first filter expression format type is different than the second filter expression format type. As previously noted above, the type refers to the formatting of the filter expressions within the request or publication message. The Examiner's cited reference of Herz, however, is silent as to the formatting of filter expressions within the alleged request (i.e., profile) and the alleged publication message (i.e., news article). Thus, for the reasons stated above, Applicants submit that the imposed rejection of claims 8-9 and 11-14 under 35 U.S.C. § 102 for anticipation based upon Herz is not factually viable. Therefore, Applicants respectfully solicit withdrawal of the imposed rejection of claims 8-9 and 11-14 under 35 U.S.C. § 102 for anticipation based upon Herz.

² 535 U.S. 722, 122 S.Ct. 1831, 1838, 62 USPQ2d 1705, 1710 (2002).

CLAIMS 8-14 ARE REJECTED UNDER 35 U.S.C. § 102 FOR ANTICIPATION BASED UPON

JANNU ET AL. U.S. PATENT NO. 7,216,181 (HEREINAFTER JANNU)

On pages 9-12 of the Sixth Office Action, the Examiner asserted that Jannu discloses the invention corresponding to that claimed. This rejection is respectfully traversed.

With regard to claim 8, the Examiner asserted the following on page 11 of the Office Action:

As to claim 8, Jannu teaches a method for receiving publications and forwarding said publication on to parties who have subscribed to receive such publications, said method comprising: receiving a subscription request (col. 6, lines 9-11) of a first type (col. 6, lines 6-9, **the "first" type could be a mainframe, CORBA, or JMS message**), said request including a filter expression having at least one attribute (col. 6, lines 16-22, **the information which registers the interest is considered the filter expression with an attribute**); receiving a publication message (col. 6, line 18) of a second type (col. 6, lines 6-9, **the "second" type could be a mainframe, CORBA, or JMS message**); comparing the publication message received to the subscription request to determine whether the publication message is appropriate for forwarding onto a subscriber originating the request (col. 6, lines 16-22), the step of comparing comprising: identifying a generic format filter attribute (col. 6, lines 58-64, **the structured event format**); and mapping the generic format filter attribute to a format corresponding to the second message type (col. 6, lines 58-64), the method further comprising: transmitting said publication message to the originating subscriber (col. 6, lines 21-22). (emphasis in original)

Claim 8 recites, in part, "mapping at least part of the at least one attribute to a generic format." However, upon reviewing the Examiner's statement of the rejection, the Examiner has not even alleged that Jannu teaches this particular limitation. Thus, on this basis alone, the Examiner has failed to establish a *prima facie* case of anticipation.

Moreover, as previously noted, the claims have been amended to clarify that the first type is first filter expression format type and the second type is a second filter expression format type and that the first filter expression format type is different than the second filter expression format type. As previously noted above, the type refers to the formatting of the filter expressions within the request or publication message. The Examiner's cited reference of Jannu, however, is silent

as to the formatting of filter expressions within the alleged request (i.e., list of subscribers and the types of messages they have registered to receive) and the alleged publication message (i.e., message sent by publisher). Thus, for the reasons stated above, Applicants submit that the imposed rejection of claims 8-14 under 35 U.S.C. § 102 for anticipation based upon Jannu is not factually viable. Therefore, Applicants respectfully solicit withdrawal of the imposed rejection of claims 8-14 under 35 U.S.C. § 102 for anticipation based upon Jannu.

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

Although Applicants believe that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction. (emphasis added)

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

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